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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,274	10/13/2006	Yuichi Tsuji	71,051-022	6627
27305 7590 04/17/2009 HOWARD & HOWARD ATTORNEYS PLLC 450 West Fourth Street Royal Oak, MI 48067				
EXAMINER ZIMMER, MARC S				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
04/17/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/553,274

**Applicant(s)**

TSUJI ET AL.

**Examiner**

MARC S. ZIMMER

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 and 9-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 9-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- \_\_\_\_\_ Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- \_\_\_\_\_ Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 and 9-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Field et al., U.S. Patent # 4,515,884 in view of Badesha et al., U.S. Patent # 5,846,643 and/or Schlueter, U.S. Patent # 4,763,158 and also, Shudo et al., U.S. Patent Application Publication No. 2002/0146575. Field discloses a fuser member comprising a layer of vulcanized silicone rubber containing thermoconductive particles. Column 9, lines 1-15 disclose a composition that mirrors that of the instant invention in most respects but is distinguished by the fact that a condensation curable silicone rubber is used as the host matrix as opposed to a hydrosilylation-curable silicone. Nevertheless, it is contemplated at the bottom of column 8 that other silicone rubbers known to have application in the manufacture of fuser members may be used. In this connection, Badesh and Schlueter are cited to illustrate that, not only are hydrosilylation-curable systems known to be used in this capacity, but also they are generally regarded as being equivalent hosts into which conductive particles are incorporated to make fuser members. See column 5, line 67 through column 6, line 29 of Schlueter and column 6, line 52 through column 7, line 21 of Schlueter. Shudo, as before, confirms that it is known to add cerium oxide in amounts consistent with those claimed to impart thermal

stability to the composition insofar as the fuser member will be subjected to/operate in a high temperature condition.

The particle sizes of alumina and iron oxide are taught in column 10, lines 4-6 and lines 25-30 respectively.

As for claims 3, 4, and 10, the treatment of fillers with an organosilicon compound as a means making their surfaces more compatible with the host matrix into which they are blended is practiced ubiquitously. It is a particularly important operation where metal oxides are incorporated into a silicone host so as to avoid the phenomenon known as structuring or crepe hardening.

Concerning claims 5-6, and 11-20, Applicant is advised that these claims, in the Examiner's estimation, connote product-by-process in the sense that they imply formulating the metal compounds (C) and (D) into a certain state, a paste, prior to their incorporation into the overall composition. The Examiner submits that a reference need not mention this aspect for these claims to be anticipated because, whether or not the iron oxide and cerium compound are first made into a paste with portions of (A), upon blending them with the remaining portion of (A) and components (B), (E), and (F), there will be no patentable distinction between the prior art invention and the claims provided that the makeup is the same. Moreover, the carrying out of processes in a different sequences, such as blending of ingredients in a different order, has been deemed *prima facie* obvious. *In re Burhans*, 154 F.2d 690, 69 USPQ 330 (CCPA 1946) (selection of any order of performing process steps is *prima facie* obvious in the absence of new or unexpected results); see also *In re Gibson*, 39 F.2d 975, 5 USPQ 230 (CCPA 1930)

(Selection of any order of mixing ingredients is prima facie obvious.) Finally, the creation of concentrates of the base polymer and filler, as opposed to mixing the fillers directly into the bulk matrix is known and practiced with some frequency. (Usually this process would be referred to as creating a masterbatch.)

As for claim 9, Field discloses the employment of a silicone oil as the release agent but the skilled artisan recognizes that liquid agents have to be frequently replenished and tend to pollute other parts of the electrostatographic apparatus over time so solid fluororesins have been widely implemented as replacements for a silicone oil.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARC S. ZIMMER whose telephone number is (571)272-1096. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

April 15, 2009

/Marc S. Zimmer/  
Primary Examiner, Art Unit 1796